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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/687,617

10/20/2003

Katsuhiko Akiyama

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03/14/2006

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EXAMINER

BOTTS, MICHAEL K

ART UNIT

PAPER NUMBER

2176

DATE MAILED: 03/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/687,617

Applicant(s)

AKIYAMA, KATSUHIKO

Examiner

Michael K. Botts

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>October 20, 2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This document is the first Office Action on the merits. This action is responsive to the following communications:

- a. The Non-Provisional Application, which was filed on October 20, 2003, and which claims priority to Japan Patent Application 2002-305458, which was filed on October 21, 2002.
 - b. An Information Disclosure Statement (IDS), which was filed on October 20, 2003.
2. Claims 1-7 have been examined, with claims 1, 6, and 7 being the independent claims.
3. The Drawings are objected to.
4. The Abstract is objected to.
5. Claims 1-7 are rejected.

Information Disclosure Statement

6. An initialed and dated copy of applicant's IDS form 1449, which was filed on October 20, 2003, is attached to this Office Action.

Priority

7. Receipt is acknowledged of a certified copy of the claimed priority document, Japan Patent Application 2002-305458, pursuant to 37 CFR 1.55. The USPTO record

does not show receipt of an English language translation of the claimed priority document.

Drawings

8. The drawings are objected to because Figures 2-5 do not include lead lines.

Lead lines are required for each reference character except for those which indicate the surface or cross section on which they are placed. See, MPEP 608.02(q).

9. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Abstract of the Disclosure

10. The abstract of the disclosure is objected to because it exceeds 150 words in length. Correction is required. See MPEP § 608.01(b).

11. Applicant is reminded of the proper language and format for an abstract of the disclosure. The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details. The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The Specification

12. Applicant is required to update the status (pending, allowed, etc.) of all parent priority applications in the first line of the specification. The status of all citations of U.S. and foreign filed applications in the specification should also be updated where appropriate.

Claims Rejections – 35 U.S.C. 112, Second Paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 contains the indefinite language, and claims 2-5 inherit the indefinite language due to their dependence on claim 1.

14. Regarding claim 1, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention.

See MPEP § 2173.05(d).

15. In the interest of compact prosecution, the application is further examined against the prior art, as stated below, upon the assumption that the applicants may overcome the above stated rejection under 35 U.S.C. 112, second paragraph.

Claims Rejections – 35 U.S.C. 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

16. **Claims 1-4, 6, and 7** are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Cassorla, et al., (U.S. Patent 5,146,552, issued September 8, 1992) [hereinafter "Cassorla"].

Regarding **independent claim 1**, Cassorla teaches:

A document browser that merges and displays additional information with document data, including text data and/or image data, that can be displayed on a display device, comprising:

an additional information receiving means for receiving input of the additional information;

(See, Cassorla, col. 2, lines 23-25, teaching that than annotation ("additional information") may be stored within or separately from the published material.)

a browsing means for merging and displaying on the display device the document data with the additional information;

(See, Cassorla, col. 2, lines 31-35, teaching the display of the additional information with the original document data.)

a positional information obtaining means for obtaining the positional information of the additional information in the document data;

(See, Cassorla, col. 2, lines 41-44, teaching the use of relative position to fix the precise position of some annotations that the reader wants to pinpoint to a particular line or word position.)

*a properties information obtaining means for obtaining properties
information of the additional information;*

(See, Cassorla, col. 4, lines 4-42, teaching a variety of properties that may be attached to annotations, including color, type style, etc.)

*an additional information storage means for storing the additional
information with the positional information and the properties information;*

(See, Cassorla, col. 5, lines 21-24, teaching storage of notes ("additional information") in a file or partition of a file on a host system or as a separate file on the local disk of a stand-alone workstation or personal computer.)

*an additional information searching means for searching the additional
information stored in the additional information storage means based on the
properties information of the additional information; and*

(See, Cassorla, col. 9, lines 23-53, teaching search methods to recover additional information from memory storage locations and to associate that information with the appropriate text.)

*a search results display means for displaying on the display device the
search results found by the additional information searching means.*

(See, Cassorla, col. 9, lines 23-53, teaching search methods to recover additional information from memory storage locations and to associate that information with the appropriate text.)

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Regarding **dependent claim 2**, Cassorla teaches:

The document browser according to claim 1, wherein the document data is an HTML document, an XML document, or other structured document.

(See, Cassorla, col. 1, lines 12-66, teaching that the invention may be used with a structured document, including a markup language source document, and also including a document in the standardized general markup language (SGML).)

Regarding **dependent claim 3**, Cassorla teaches:

The document browser according to claim 1, wherein the properties information includes: attribute information included in the additional information such as line color, level of transparency, and line thickness; or other properties data of the additional information such as a shape classification, size, or date and time of input.

(See, Cassorla, col. 5, lines 18-21, teaching that once the reader has completed adding the additional information, the invention adds the topic, line number, author identification, date and time information to the text of the note.)

Regarding **dependent claim 4**, Cassorla teaches:

The document browser according to any of the claims 1, wherein the additional information receiving means comprises a pen tablet, a mouse, or other pointing device.

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(See, Cassorla, col. 3, line 12 through col. 4, line 3, teaching use of an appropriate action with a pointing mechanism such as a text or graphic cursor driven by a mouse, touch screen, joystick, keyboard or other command action, which is the same as the means claimed in the application.)

Regarding **independent claim 6**, claim 6 incorporates substantially similar subject matter as claimed in claim 1 and is rejected along the same rationale.

Regarding **independent claim 7**, claim 7 incorporates substantially similar subject matter as claimed in claim 1 and is rejected along the same rationale.

17. It is noted that any citations to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. See, MPEP 2123.

Claims Rejection – 35 U.S.C. 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. **Claim 5** is rejected under 35 U.S.C. 103(a) as being unpatentable over Cassorla as applied to claim 1 above, and further in view of Fitzpatrick, et al., "Translucent Window Attribute," IBM Technical Disclosure Bulletin, Vol. 36, No. 06A, pages 135-136, June 1, 1993 [hereinafter "Fitzpatrick"].

Regarding **dependent claim 5**, Cassorla in view of Fitzpatrick teaches:

The document browser according to any of the claims 1, wherein the additional information is displayed semi-transparently so that the document data is identifiable when the additional information is merged with the document data.

(Cassorla teaches the invention of claim 1, but does not expressly teach that the additional information is displayed semi-transparently so that the document data is identifiable when the additional information is merged with the document data.

Fitzpatrick expressly teaches a "translucent window," which is used when a container object is located on top of other container objects.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Cassorla for the association of annotations with a document, with the teachings of Fitzpatrick that a window containing the annotation could be placed on top of the text, with the annotation displayed semi-transparently or translucently.

The suggestion or motivation to combine the references is expressed in Fitzpatrick which states that the translucent window attribute greatly expands the

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number of objects accessible by users for a given presentation space. Rather than forcing a note to occupy a column of a display screen, overlaying a note over a document in a translucent form prevents obstruction of the underlying document and thus greatly expands the number of objects accessible to the user for a given presentation space.)

19. It is noted that any citations to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. See, MPEP 2123.

Conclusion

20. The following prior art is made of record and not relied upon that is considered pertinent to applicants' disclosure:

Graham, et al. (U.S. Patent 6,457,026 B1), teaching document annotation.

Berquist, et al. (U.S Patent 6,411,310 B1), teaching electronic notes.

Anderson, et al. (U.S. Patent 5,581,682), teaching multi-user annotations of documents.

Johnson, et al., "Electronic Posted Notes," IBM Technical Disclosure Bulletin, IBM Technical Disclosure Bulletin, Vol. 37, No. 01, pages 121-122, January 1, 1994.

Johnson, et al., "Method for Iconic Association of Posted Notes to a Calendar

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Service," IBM Technical Disclosure Bulletin, IBM Technical Disclosure Bulletin, Vol. 37, No. 01, pages 249-250, January 1, 1994.

IBM, "Method for Creating Annotation Data," Vol. 28, No. 4, pages 1623-1628, September 1985.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael K. Botts whose telephone number is 571-272-5533. The examiner can normally be reached on Monday Thru Friday 8:00-4:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MKB/mkb



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